

Remarks/Arguments begins on page 2 of this paper.

### **REMARKS**

Claims 15-24 remain in the present application. None of the claims have been amended by this Response.

### **DOUBLE PATENTING**

The Examiner has provisionally rejected claims 15-24 under the judicially created doctrine of obviousness-type double patenting being unpatentable over claims 1-14 and 17 of co-pending application Serial No. 09/684,129 in view of U.S. Patent No. 6,039,356 (Warther et al) as noted in paragraph 1 of the Office Action.

In light of the fact that, at this stage of the prosecution, claims have not been allowed in the present application or the co-pending application, it is respectfully submitted that the submission of a Terminal Disclaimer be delayed pending the allowance of claims in either of the two cases.

Applicants are prepared to file a Terminal Disclaimer at a stage when the provisional double patenting rejection is the only rejection remaining in the application and the other application has issued.

### **CLAIM REJECTIONS – 35 U.S.C. §103**

Claims 15-24 have been rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,509,693 (Kohls) in view of U.S. Patent No. 6,022,051 (Casagrande) and further in

view of U.S. Patent No. 6,039,356 (Warther et al). The Examiner takes the position that Kohls discloses the claimed invention except for printed information printed on a front face of the outer surface of the rear card panel of the card. The Examiner claims that this feature would have been obvious to one of ordinary skill in the art.

The Examiner also takes the position that Kohls discloses the claimed invention except for the liner being a siliconized liner patch. The Examiner claims that this feature is well-known in the art.

The Examiner also takes the position that Kohls discloses the claimed invention except for a face patch of clear poly material immovably secured over the card region of the front face of the carrier sheet. It is the Examiner's position that Casagrande provides this teaching. The Examiner also cites Warther et al as teaching printed sheet products comprising transaction cards spaced in aide-by-aide relationship having magnetic stripes.

The rejection of claim 15 under 35 U.S.C. §103 is respectfully traversed.

In summary, the specific structure recited in claim 15 with regard to the creation of an integrated card having front and rear card panels is neither taught nor suggested by the Kohls reference. This conclusion will now be presented in detail with initial consideration of the important points presented in claim 15 and then a discussion of the details of the Kohls reference to show why those features are neither taught nor suggested by the reference.

The present invention as provided for in claim 15, relates to a carrier sheet with an integrated card. The carrier sheet has printed information on it. Of particular importance is the

location of the printed information at a pre-determined location on a front face of the carrier sheet in a card region of the sheet.

The provision of printed materials on the carrier and the card is not what is of significance. What is of significance is that the printed information must be oriented to be disposed on an outer surface of a front and a rear card panel of a card to be formed.

Also important is that there be a siliconized liner patch containing a pressure-sensitive adhesive surface which is laminated on a back surface of the carrier sheet and disposed to extend over the card region where the card region includes both the front and rear card panels of the card to be formed. A magnetic strip patch is immovably secured over the card region on an outer surface of a magnetic strip panel.

A die-cut delineates the front and rear card panels disposed adjacent to one another and the magnetic strip panel adjacent the front panel and does so by extending through a face patch and the carrier sheet. The die-cut panels are retained in the carrier sheet by the pressure sensitive adhesive that is on the siliconized liner patch.

Straight fold lines are formed in the face patch between the front and rear card panels and between the magnetic strip panel and the front card panel. The card can be formed by peeling off the front and rear card panels from the carrier sheet with the pressure sensitive adhesive releasing from the siliconized liner patch whereby the adhesive now lies on the back face of the front and rear card panels and the magnetic card panel. The panels are then folded along the straight fold line to mate and be held together by the adhesive that appears on the back face of the front and back panels and on the back of the magnetic card panel.

This is to be contrasted against the Kohls reference which relates to a protected printed identification card with accompanying letters or business forms. With reference to Figures 1, 2 and 4, the Kohls reference teaches the creation of an ID card 50 that is made up of a single card piece that is derived from a carrier sheet that has a business form portion 12 and an ID card portion 14. Figure 1 shows the front face of the ID card. Figure 2 shows the back view of the business form and in that way shows the back face of the ID card. The back view of the ID card is shown on the right-hand side and labeled 50. This is the portion of the ID card that is shown as being die-cut in Figure 1 by the die-cut 32. To the left of that, the front and back of the business form 12 remain uncut.

In the ID card portion 14 as shown in Figure 2, which is a back view of the business form, the back surface 44 of the business form is coated with a laminate liner 42 that contains an adhesive 40 for holding the laminate liner to the back face of the ID card 50. Also, before the laminate liner is placed on the back surface 44, a silicon spot coat as shown in dotted lines is placed on the uncut portion of the sheet which is on the left-hand side as oriented in Figure 2. This silicon spot coat 36 prevents the adhesive from securing to the left-side portion of the business form.

In the construction of the card, a die-cut 32 is made through the ID card 50 as well as the laminate liner 42. Also a partial die-cut 34 is made only through the laminate liner. In this way, when the card is removed, by pushing the card into the paper from the view shown in Figure 1, the card is removed and attached to it is the laminate liner 42. This liner is then folded over at

the perf line 38 to cover the front face of the ID card. In this way, an ID card made up of a single sheet is then laminated on both side by the laminate layer 42.

Thus, it can be seen that the Kohls reference fails to teach or suggest several critical elements recited in claim 15. Kohls does not teach the provision of a carrier sheet with an integrated card where the integrated card presents an outer surface of a front and rear card panel on the front of the carrier sheet so that it can receive printing on both front and rear card panels of a card to be formed. By not providing the front and rear card panels on the carrier sheet, the Kohls reference cannot teach any of the recited elements that rely on the front and rear card panels as part of their construction. For example, in claim 15, the siliconized liner patch contains a pressure sensitive adhesive that is disposed to extend over the card region where the card region is previously defined as the front and rear card panels. Also, there is no way for the face patch of clear poly material to be secured over the card region on the front face of the carrier sheet and thereby cover the front and rear card panels. Finally, there is no provision in Kohls for a die-cut that delineates the front and rear card panels disposed adjacent one another and a magnetic strip panel adjacent the front panel where the die-cut extends through the face patch and the carrier sheet. Also, there is no teaching in Kohls, because of the lack of the front and rear card panels and the magnetic strip panel, to be able to peel off the front and rear card panels and the magnetic strip panel from the carrier sheets with the pressure sensitive adhesive releasing from the siliconized liner patch in order to form the card with the folded magnetic strip panel.

In light of the above, it is respectfully submitted that claim 15 may not be rejected under 35 U.S.C. §103 as being unpatentable over Kohls in view of Casagrande and further in view of

Warther et al. As has already been stated by the Examiner, the Casagrande reference is cited for its teaching of the face patch of clear poly material and Warthers is cited for the use of a magnetic strip. Nevertheless, the references provide none of the other critical teachings as commented on hereinbefore with reference to the Kohls patent.

Claims 16-20 trace their dependence to claim 15 and as such incorporate all of the limitations of that claim. For at least for the reasons previously presented, claims 16-20 are likewise in condition for allowance and may no longer be rejected under 35 U.S.C. §103 as being unpatentable over Kohls in view of Casagrande and further in view of Warther.

The Examiner has rejected claim 21 under 35 U.S.C. §103 as being unpatentable over Kohls in view Casagrande and further in view of Warther et al.

An examination of claim 21 reveals, even though it is a method claim, the requirements with regard to the card region on the carrier sheet being presented as an outer surface that has a front and a rear card panel and also the provision of a separate magnetic strip panel. This construction is carried throughout the claim and essentially tracks the manufacture of the elements that are provided for in the carrier sheet and integrated card of claim 15. Thus, all of the previous comments presented with regard to claim 15 likewise apply to claim 21. This is especially true with regard to the application of the siliconized liner patch where it extends over the card region which is made up of the front and rear panels . Also true is a lack of teaching for die cutting the front and rear card panels in the card region and the magnetic strip panel where the die cut extends through the face patch and the carrier sheet.

Thus, it is respectfully submitted that claim 21 may not be rejected under 35 U.S.C. §103 as being unpatentable over Kohls in view of Casagrande further in view of Warther et al.

Claim 22-24 can trace their dependence to claim 21 and as such incorporate the limitations of that claim. For at least the previous reasons expressed with regard to claim 15, claims 22-24 may not be rejected under 35 U.S.C. §103 as being unpatentable over Kohls in view of Casagrande and further in view of Warther et al.

Finally, in view of the arguments previously presented, it is applicants' position that none of the claims may be rejected as being anticipated or made obvious by any of the references of record taken alone or in combination.

Applicants note the Examiner's response to the previous arguments and also the citation of prior art made of record and not relied upon.

Thus, it now appears that the application is condition for allowance. Should the Examiner have any questions or require additional information after reviewing this Response, she is cordially invited to call the undersigned so that this case may receive an early notice of allowance. Further, if the Examiner does not find the application to be allowable, then it is respectfully requested that she contact the undersigned attorney to set up an interview.


We have concurrently filed herewith a Petition for Extension of Time – One Month with the requisite fee. If there any additional fees in connection with the filing of this Response and

Amendment, the Commissioner is authorized to charge our Deposit Account No. 06-1358 for any such deficiencies.

Respectfully submitted,

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